

REMARKS**AMENDMENTS TO THE SPECIFICATION**

The Examiner rendered no rejections with respect to the Applicants' previous amendment to the specification. As such, the Applicants presume the previously presented amendments to have been entered into the record.

REJECTIONS UNDER 35 U.S.C. § 103(A)

The Examiner has rejected independent claims 1, 20, and 21 "under 35 U.S.C. 103(a) as being unpatentable over Patel et al. . . . in view of Malcolm et al." *Final Office Action*, 2. The Applicants respectfully traverse.

LACK OF MOTIVATION TO COMBINE

As an initial matter, the Applicants believe that the Examiner still has failed to meet its burden with respect to a *prima facie* case of obviousness in light of the previous amendment to claim 1. Claim 1, in the Applicants' prior response, was amended to incorporate the limitations of previously pending (and now cancelled) claim 10. In that amendment, the Applicants argued that to "maximize efficiency of the system" did not constitute proper motivation to combine. See *Amendment A*, 12 (quoting (Non-Final) *Office Action*, 9 (citing Malcolm at [0010])).

The Applicants again make note of the fact that [0003] of Malcolm concerns Malcolm's pertinence "to devices for caching objects transmitted using a computer network." Malcolm utilizes a cache engine "to maximize efficiency" and to "atomically commit changes to disk during each write episode, so the cache engine does not fail in response to loss power or storage, or other intermediate failure of portions of the cache."

Malcolm does so with respect to seeking to address problems related to "delay or restricted functionality from having to use a local operating system and local file system or file server." Malcolm, [0008]. That said, there is no suggestion whatsoever that the caching taught by Malcolm (regardless of the use of a canonical equivalent) has any applicability and/or relevance with respect to the classification of electronic mail.

The Examiner now contends that "allow[ing] different items, which in fact present the same entity, to be identified," is sufficient motivation to combine Malcolm and Patel. *Final Office Action*, 3. The Examiner, however, provides no evidentiary or factual basis in the art or in the general knowledge of one of ordinary skill in the art as to why this would constitute a motivation to combine Malcolm and Patel. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (finding that "[t]o support the conclusion that the claimed invention is directed to obvious subject matter . . . the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references"). Simply reciting the missing element from a prior anticipation rejection does not, as a matter of law, constitute a motivation to combine the references. To do so would—if anything—suggest the impermissible application of hindsight. See *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

NO EXPECTATION OF SUCCESS

Further, the Applicants contend that the combination of Patel and Malcolm would have little to no expectation of success. Such an expectation constitutes the third prong of a *prima facie* case of obviousness along with motivation to combine and disclosure of all elements of the claimed invention. See MPEP § 2142. Specifically, the Applicants reference columns 4 and 5, both at lines 52-58 of Malcolm. The Examiner expressly relies on these same portions of Malcolm to purportedly disclose the Applicants'

claimed 'identification of all items of a certain type in a message body.' See *Final Office Action*, 2.

A closer reading of this portion of Malcolm, however, reveals that "[i]f a key word is found, the e-mail message is **discarded without further processing.**" Col. 5, l. 54-55 (emphasis added). Likewise, Malcolm in column 4 states that once the mail transfer agent is informed of a message with a particular keyword, **the message may be discarded.** See col. 4, l. 54-55. If a message were to be immediately discarded as suggested by the blacklist/keyword list of Malcolm, then there would be no need to reduce such a blacklisted word to a canonical equivalent or undertake any other sort of comparison with respect to a criterion as claimed. If a particular word (or item) is present in Malcolm, the message is disposed without further analysis.

This 'on the spot' disposal of messages is counterintuitive to the methodology of the presently claimed invention. The Applicants' presently claimed invention requires, in claim 1 for example, identification of all instances of the items of a certain type for each of the one or more items of a certain type identified during parsing of the message body. Each of the all instances of the items of a certain type for each of the one or more items of a certain type is then reduced to a canonical equivalent. A determination is then made as to whether the canonical equivalent of each of the all instances of the items of a certain type for each of the one or more items of a certain type meets a criterion. That criterion corresponds to an acceptable item. Malcolm, however, identifies an **unacceptable item** and the process comes to an end. The present invention and Malcolm are diametrically opposed with respect to their claimed operation.

While obviousness does not require absolute predictability, there must be some degree of predictability with respect to success of a proposed combination of art. Lack thereof—or evidence to the contrary as is presented here—may support a conclusion of non-obviousness. See *In re Rinehart*, 531 F.2d 1048 (CCPA 1976). In this context, the claimed invention *and* the references must be considered as a whole. See *Hodosh*, 786 F.2d at 1143 n.5. Careful attention must be given to the cited art if it would, in fact, teach away from the claimed invention—as is the case here. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983); *cert denied*, 469 U.S. 851 (1984). As the cited art teaches away from the presently claimed invention vis-à-vis a failed implementation to achieve the same and, further, fails to disclose each and every element as addressed below, the Applicants contend the Examiner's 35 U.S.C. § 103(a) rejection to have been overcome.

NEW CLAIM 25

The Applicants note that they have also presented new claim 25, which generally corresponds to claim 1 as previously presented and finally rejected. New claim 25 does, however, add the additional limitation that with respect to the reduction of an item to a canonical equivalent, the canonical equivalent identifies a group of synonymous words, numbers, symbols, or phrases, and wherein the canonical equivalent represents each of the all items of a certain type regardless of individual format of each of the all instances of items of the certain type. New claim 25 is believed to be allowable over Malcolm and Patel for at least the reasons set forth above.

**AMENDED INDEPENDENT CLAIMS
(LACK OF EACH AND EVERY ELEMENT IN THE ART)**

Notwithstanding the lack of motivation to combine and the lack of a reasonable expectation of success as detailed above, the Applicants wish to expedite the prosecution of the present application. As such, the Applicants have further amended independent claims 1, 20, and 21. The Applicants believe that the proposed combination of Malcolm and Patel fails to disclose the claims as amended herein.

Claim 1 now recites 'parsing the message body to determine whether the message body includes one or more items of a certain type, wherein the one or more items of a certain type may be used to classify the message.' For example, a message might be parsed to identify all email addresses, URLs, and phone numbers—each of the aforementioned constituting an item of a certain item. Each of these items may, in certain embodiments, be used to classify a message as 'friendly' or unwanted 'spam.'

Claim 1 further recites identifying all instances of the items of a certain type for each of the one or more items of a certain type identified during parsing of the message body. In this step, all instances of a phone number may be identified as would all instances of an email address and URL. Each of these instances of an item of a certain type would then be reduced to a canonical equivalent.

The canonical equivalent, as presently amended, represents each of the all instances of items of a certain type regardless of individual format of each of the all instances of items of the certain type. Thus, a phone number presented as 1.555.555.555 would be reduced just as would the number 1-555-555-5555. Likewise, the email address spam@spam-guy.com would be processed in a manner similar to that of spam@spanguy.com with respect to a canonical equivalent.

These additional limitations are not found in the combination of Malcolm and Patel, regardless of the lack of a motivation to combine or reasonable expectation of success. As such, the Applicants contend that independent claims 1, 20, and 21 are allowable over the cited art of record. The Examiner's rejection should, therefore, be withdrawn.

CONCLUSION

The Applicants have, again, evidenced the lack of motivation to combine Malcolm and Patel. The Applicants have further evidenced the lack of any reasonable expectation of success with respect to arriving at the presently claimed invention via a combination of Patel and Malcolm. Patel and Malcolm, further, fail to disclose each and every element of the claims as currently amended.


Any claim dependent upon one of the aforementioned independent claims—either directly or via an intermediate dependent claim—is allowable for at least the same reasons as the claim from which it depends. As such, each and every one of the dependent claims of the present application are also in condition for allowance.

As all rejections have been overcome, the Applicants contend the present application is in condition for allowance. The Examiner is invited to contact the Applicants' undersigned representative with any questions concerning the present amendment.

Respectfully submitted,
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